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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,569	02/01/2002	Gordon Ko	5981	2762

7590 05/15/2003

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EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No. 10/061,569	Applicant(s) KO, GORDON	
	Examiner Patricia L Engle	Art Unit 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,10-15,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,10-15,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fastener means for detachably securing the second end portion of the elastic strap to a second one of the shield pads (claims 1, 5, 10, 11, 13, 18 and 19) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 1, 5-6, 10-15, 18 and 19 are objected to because of the following informalities: in the last paragraph of claims 1, 10, 11, 18 and 19, "vehicle sides" should be --vehicle side surfaces--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 5, 6, 10-15, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 5, 6, 10-15, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: How does the fastener means detachably secure the second end portion of the elastic strap to a second one of the shield pads when in a rolled position as shown in Figure 6? In the drawings the second end of the elastic strap is fastened to the first panel. If the two panels were "rolled" so that the panels lay on top of each other, it would be understandable how the elastic strap could be connected to both panels.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5, 11, 12, 13, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spears (US Patent 4,810,013) in view of Huard (US Patent 4,974,892).

Spears discloses a removably attachable shielding to protect vehicle side surfaces and doors to prevent dents and scratches imposed by doors of adjacent vehicles, said shielding comprising: two shield pads (11a,11b) of impact absorbing

material, at least one strap (19,21,23) secured to a lateral edge portion (43) of each of said shield pads (11a,11b) to connect them together, an elastic strap (27) having an end thereof secured to an edge portion (45) of a first one (11a) of the shield pads, and fastener means (57) for detachably securing a second end portion (25) of the elastic strap (27) to a second one of the shield pads, whereby the protective shields are removably attachable to the vehicle side surfaces and doors, and removable therefrom and rollable together. The verb roll is defined as to cause to move forward along a surface by revolving on an axis or by repeatedly turning over.¹ The shield pads (11a,11b) of Spears are revolved on an axis (located between the two pads) to move one of the pads forwardly and on top of the other shield pad. Therefore the shield pads of Spears are rollable. Regarding claim 11, Spears discloses that the two spaced apart straps extend between and are secured to lateral edge portions (43) of the two shield pads (11a,11b).

Spears does not disclose the suction cups are used to attach the pads to the vehicle.

Huard discloses a shield pad for a vehicle which is attached to the vehicle by a suction cup. Regarding claim 12, Huard discloses two spaced apart suction cups to attach the shield to the door in Figure 3.

Huard and Spears are analogous art because they are from the same field of endeavor, i.e., protective pads for vehicle sides and vehicle doors.

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction

At the time of the invention, it would have been obvious to one of ordinary skill in the art to mount the shield pads with suction cups.

The motivation would have been to prevent the shield pads from moving around on the vehicle side when installed.

Therefore, it would have been obvious to combine Huard with Spears to obtain the invention as specified in claim 1, 11, 12.

Regarding claims 5, 13, 15 and 19, Spears as modified does not disclose cooperating male and female snap fasteners, one on an end portion of the elastic strap and the other on an edge portion of the shield pad. At the time of the invention it would have been obvious to one of ordinary skill in the art to include snap fastener means on the elastic straps. The motivation would have been to hold the two components together in the compact position so that when the door guard was stored in the trunk of the vehicle, it would stay together while the vehicle was being driven. There are many examples of two panels being held together in a compact position by an strap with snap fasteners. Some of the examples are a travel jewelry box, travel wardrobe suitcases, flexible briefcases. Although these examples are not door guards, they are two panels which are held closed by a strap with snap connections.

8. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spears as modified as applied to claims 1 and 11 above, and further in view of McNeil.

Regarding claims 6 and 14, Spears does not disclose that the two spaced apart straps are secured to an edge portion of the shield by riveting. McNeil discloses that it

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is known to attach straps to edge portions of shields by riveting (column 2, lines 65-66). It would have been obvious to one of ordinary skill in the art at the time of the invention to connect the straps to the shield pads by rivets as taught by McNeil. The motivation would have been to simplify the connection of the straps and the shields.

Allowable Subject Matter

9. Claims 10 and 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

10. Applicant's arguments filed April 18, 2003 have been fully considered but they are not persuasive.

11. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

The use of 3 references does not mean that there is a lack of obviousness in the prior art. However, the Examiner has now changed the rejection of claims 1, 5, 11-13, 15 and 19 to only use 2 references. McNeil is now only used to teach that it is known to use rivets to attach the elastic strap to the panels.

12. In response to applicant's argument that an umbrella is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, an umbrella is a teaching of a method of holding a rolled item rolled and would be reasonably pertinent to the particular problem of holding a rolled item rolled. Sleeping bags are another example of holding a flexible material in the rolled position with a strap attached to one end of the flexible material. Also, suitcases, flexible briefcases and travel jewelry boxes teach two panels being held in the closed or compact position with a strap and snap fasteners.

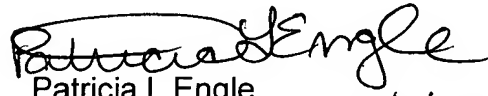
Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777. The examiner can normally be reached on Monday - Friday from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Patricia L Engle
Examiner
Art Unit 3612

5/9/03

ple
May 9, 2003